

Remarks

Claims 34, 37-40, 58-114 are pending the application. New claims 78-114 have been
added.

Claims 1-33 have been canceled solely because they correspond to a non-elected invention. The Applicants expressly reserve the right to prosecute in subsequent divisional applications or continuing applications or both claims covering the subject matter of the claims canceled to conform with the Applicants election in response to the Restriction Requirement. 35 U.S.C. §§ 120-121.

Claims 35, 36, and 41-57 have been canceled, and the new claims have been added, in light of the narrow scope of the disclosure of '176 patent. In other words, due to the logistics of claim amendments, claim 34 could only be amended so as to decrease its scope beyond that required by the '176 patent; accordingly, the new claims have been added to recapture the decrease in the scope of claim 34 beyond that required by the '176 patent. Specifically, as mentioned above, new claims 78-114 have been added. Support for the new claims can be found in the specification, e.g., in original claims. Therefore, the Applicants respectfully submit that no new matter has been entered by the amendments.

The Examiner also required an election of species which read on claims 34-39, 41-57, and 70. Claims 34-39, 41-57, and 70 stand rejected under 35 U.S.C. 112, 2nd paragraph. Claims 34-39, 41-57, and 70 also stand rejected under 35 U.S.C. 102(b).

Claims 34, 37, and 38, have been amended to address the alleged ambiguity of the Applicants' use of the term "substituted". In light of the '176 patent and two foreign language references, claims 34 and 39 have been amended to further define the compound of structure 1. Support for these claim amendments can be found on pages 7, 8, and 9 (at lines 22-27) of the specification.

Response to Rejections under 35 U.S.C. 112, 2nd Paragraph

Claims 34-39, 41-57, and 70 stand rejected under 35 U.S.C. 112, 2nd paragraph for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention. Specifically, the Examiner contends it is unclear whether the term "substituted" in

claims 34, 37, 38, 43-46, 49, 50, and 52-55 refers only to the first moiety of the series or to every moiety of the series. For reasons discussed elsewhere in this paper, a number of these claims have been canceled. In response, but solely to expedite prosecution, the Applicants have amended the rejected claims that have not been canceled, replacing the word "optionally" with "an unsubstituted or." These amendments do not reflect a change in scope of the invention for which protection is sought, i.e., the Applicants respectfully contend that "unsubstituted or substituted" is synonymous with "optionally substituted."

Further, the Applicants believe that the only other effective alternative to the current wording of the claims would be to precede each group in the relevant series with the phrase "unsubstituted or substituted". However, the Applicants respectfully contend that this latter claim construction would amount to forbidden prolixity. Of course, the Applicants are receptive to specific suggestions from the Examiner as to how the rejected claims might be rendered more definite, so long as the suggestions would not result in a decrease in the scope of the claimed invention.

Accordingly, the Applicants respectfully request the withdrawal of the claim rejections under 35 U.S.C. 112, 2nd paragraph.

Response to Rejections under 35 U.S.C. 102(b)

Claims 34-39, 41-57, and 70 stand rejected under 35 U.S.C. 102(b), based on the Examiner's contention that they are anticipated by Zimmerman *et al.*, U.S. Patent No. 5,384,176 ("the '176 patent"). The Applicants respectfully disagree.

The '176 patent discloses zosteric acid and other sulfate esters of phenolic acids. Consequently, claim 34 has been amended so that when X is OH, and Y is O, the definition of Z does not encompass the aryl moieties comprised by the compounds disclosed in the '176 patent. Therefore, the Applicants respectfully assert that the amended claim 34 and the claims that depend upon it are not anticipated by the '176 patent.

Additionally, the Applicants have added new claims, covering compounds within the scope of claim 34 as filed, i.e., prior to amendment, wherein either X is not OH (i.e., claims 78-101), or Y is not O (i.e., claims 102-114), and the definition of Z has not been narrowed. The



Applicants respectfully contend that these claims are described in and enabled by the Specification, e.g., which describes and teaches compounds wherein X is Cl, and Y is O.

Finally, various claims have been amended, e.g., by removing "octyl" from the Markush group defining Z in claims 39, in light of the teachings of References EB and EC, for which English translations are not currently available.

Accordingly, the Applicants respectfully request the withdrawal of the claim rejections based on 35 U.S.C. 102(b).

Conclusion

In view of the above amendments and remarks, the Applicants believe that the pending claims are in condition for allowance. If a telephone conversation with Applicant's Agent would expedite prosecution of the application, the Examiner is urged to contact the undersigned. A clean version of the claims follows.

Respectfully submitted,
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